

Margalit and Tomita alone or in a permissible combination, do not teach and would not have rendered obvious a "function implementing unit that, when instruction data is stored in the storing unit via the interface the external personal computer, automatically reads the instruction data, determines a process to implement one of the one or more functions corresponding to the read instruction data and executes the determined process," as recited in independent claim 1 (Emphasis added).

The Office Action relies on Margalit for disclosure of the above feature. (See Office Action, page 4). While the USB host 20 or 120 of Margalit may be a personal computer, Margalit merely relates to writing the data to or reading the data from the firmware memory, the RAM or the user's data memory (see col. 2, lines 37-46 of Margalit). The CPU 30 of Margalit does not implement any function based on the (instruction) data read from memory and thus does not correspond to the function implementing unit of the claimed invention.

Therefore, Margalit does not teach "function implementing unit that, when instruction data is stored in the storing unit via the interface the external personal computer, automatically reads the instruction data, determines a process to implement one of the one or more functions corresponding to the read instruction data and executes the determined process," as recited in independent claim 1 (Emphasis added).

The Office Action acknowledges that Margalit does not disclose automatically reading instruction data, and executing the determined process recited in independent claim 1. (See Office Action, page 4).

The Office Action relies on Tomita for disclosure of the above feature. (See Office Action, page 4).

However, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir.

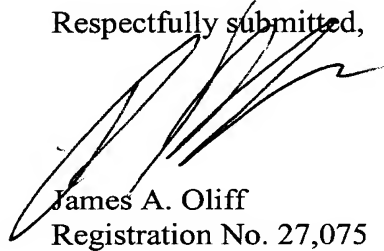
1984); see also MPEP §2143.01(V). The purpose of Tomita is to provide an image processing apparatus (i.e. printer), an image processing method (i.e. print processes), and a program that enable both a rewrite process of firmware and an image processing job (i.e. print job), which may be automatically executed. See Tomita, paragraph [0009]. The purpose of the USB key apparatus in Margalit is to provide an improved USB apparatus for interacting with a USB Host via a USB port. See Margalit, col. 1, lines 37-43. Tomita is merely relied upon for its disclosure of executing a print process automatically. See Tomita, paragraph [0100]. Therefore, such a result would be unsatisfactory for Margalit's intended purpose of providing an improved USB key apparatus, because the apparatus of Margalit does not disclose, nor is capable, of incorporating a printing function.

Therefore, for at least these reasons, independent claim 1 is patentable over the above applied references. Claims 2-7 and 15-19 which depend from independent claim 1, are also patentable for at least their dependency on independent claim 1, as well as for the additional features they recite. Applicants thus respectfully request withdrawal of the rejection.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Patrick T. Muffo
Registration No. 60,342

JAO:JZH/mcp

Date: November 19, 2009

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
